

(3)

Supreme Court, U.S.  
FILED

JAN 21 1992

OFFICE OF THE CLERK

No. 91-1002

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1991

**YOUNG & RUBICAM, INC.,**  
*Petitioner,*

vs.

**BETTE MIDLER,**  
*Respondent.*

PETITION FOR WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

**RESPONDENT'S BRIEF IN OPPOSITION**

**PETER LAIRD, ESQ.**

*Counsel of Record*

**RALPH C. LOEB, ESQ.**

**ARROW EDELSTEIN & LAIRD, P.C.**

9220 Sunset Boulevard

Suite 302

Los Angeles, California 90069

(310) 274-6184

*Attorneys for Respondent*

**BETTE MIDLER**

### QUESTIONS PRESENTED

1. Whether the California common law tort defined by the Ninth Circuit as existing when the distinctive voice of a professional singer who is widely known is deliberately imitated in order to sell a product constitutes one of the rights expressly preserved from federal preemption by §301(b) of the Copyright Act because the tort (a) arises from rights that are not equivalent to any of the exclusive rights within the general scope of copyright, and (b) does not arise from a work of authorship that is fixed in a tangible medium of expression, and does not come within the subject matter of copyright?
2. Whether Young & Rubicam, Inc. failed to preserve the preemption question raised in its petition for writ of certiorari in the Court of Appeals?

TABLE OF CONTENTS

Table of Authorities . . . . .	<u>Page</u> iv
STATEMENT OF JURISDICTION. . . . .	2
OPINIONS BELOW . . . . .	2
STATEMENT OF THE CASE. . . . .	2
REASONS FOR DENYING WRIT. . . . .	13

POINT I

THE PREEMPTION QUESTION RAISED BY YOUNG & RUBICAM, INC. WITH RESPECT TO MIDLER I DOES NOT CONSTITUTE AN IMPORTANT ISSUE OF FEDERAL COPYRIGHT LAW WORTHY OF SUPREME COURT REVIEW . . . . . 16

POINT II

THE NINTH CIRCUIT'S OPINION IN MIDLER I DOES NOT CONFLICT WITH THE OPINION OF ANY OTHER CIRCUITS ON THE ISSUE OF PRE-EMPTION . . . . . 20

POINT III

THE PREEMPTION QUESTION POSED BY YOUNG & RUBICAM, INC. SHOULD NOT BE REVIEWED BECAUSE YOUNG & RUBICAM, INC. DID NOT PRESERVE THE QUESTION IN THE COURT OF APPEALS . . . . . 26

POINT IV

THE MIDLER I DECISION DID NOT IMPOSE LIABILITY ON YOUNG & RUBICAM, INC. FOR CONDUCT PERMITTED BY THE COPYRIGHT ACT . . . . . 29

POINT V

THE TORT RECOGNIZED IN MIDLER I IS NOT  
 PREEMPTED BY §301 OF THE COPYRIGHT ACT  
 DOES NOT CONFLICT WITH THE HOLDING IN  
BONITO BOATS AND DOES NOT INTERFERE  
 WITH THE REGULATORY SCHEME ESTABLISHED  
 BY CONGRESS . . . . . 32

CONCLUSION. . . . . 38

TABLE OF AUTHORITIES

<u>CASES</u>	<u>PAGE</u>
<u>Baltimore Orioles v. Major League Baseball Players,</u> 805 F.2d 663 (7th Cir. 1986) <u>cert. denied,</u> 48 U.S. 941 (1987). . . . .	21,22,23,24,33
<u>Bonito Boats, Inc. v. Thunder Craft Boats, Inc.,</u> 489 U.S. 141 (1987) . . . . .	34,35,36
<u>Compco Corp. v. Day-Brite Lighting, Inc.,</u> 376 U.S. 234 (1964) . . . . .	35,36
<u>Diamond v. Chakrabarty,</u> 47 U.S. 303, 309 (1980) . . . . .	35
<u>Heckler v. Campbell,</u> 461 U.S. 458 (1983) . . . . .	26
<u>Kosak v. U.S.,</u> 465 U.S. 848, (1984). . . . .	26
<u>Lahr v. Adell Chemical Co.,</u> 300 F.2d 256 (1st Cir. 1962). . .	13,24
<u>Laing v. United States,</u> 423 U.S. 161 (1976) . . . . .	17
<u>Layne &amp; Co. v. Western Well Works,</u> 261 U.S. 387 (1923) . . . . .	20
<u>Midler v. Ford Motor Co.,</u> 849 F.2d 460, (9th Cir. 1988) . .	5,35
<u>Motschenbacher v. R.J. Reynolds Tobacco Co.,</u> 498 F.2d 821 (9th Cir. 1974) . . . .	6

Patterson v. Lamb,  
329 U.S. 539 (1947). . . . . 17

Roberts v. Lodge,  
45 U.S. 613 (1982) . . . . . 26

Rothensies v.  
Electric Battery Co.,  
329 U.S. 296 (1946). . . . . 17

Sears, Roebuck & Co. v.  
Stiffel Co.,  
376 U.S. 225 (1964). . . . . 35

Sinatra v. Goodyear Tire &  
Rubber Co.,  
435 F.2d 711 (9th Cir. 1970) cert.  
denied, 402 U.S. 906 (1971). . 7,14,25

Tin Pan Apple, Inc. v.  
Miller Brewing Co., Inc.,  
737 F.Supp. 826 (S.D.N.Y. 1990). . . 25

Wisconsin Electric Co. v.  
Dumove Co.,  
282 U.S. 813 (1930). . . . . 20

Zacchini v. Scripps-Howard  
Broadcasting Co.,  
433 U.S. 562 (1977). . . . . 14,37

## STATUTES

California Civil Code  
Section 3344 . . . . . 4

## Copyright Act of 1976

17 U.S.C. §101 . . . . . 23,31

17 U.S.C. §102 . . . . . 33

17 U.S.C. §106 . . . . . 33

17 U.S.C. §114 . . . .	13,14,30,31
17 U.S.C. §201 . . . . .	22
17 U.S.C. §301 . . . . .	32,37

NO. 91-1002

---

---

IN THE  
SUPREME COURT OF THE UNITED STATES  
October Term, 1991

---

YOUNG & RUBICAM, INC.,

Petitioner,

v.

BETTE MIDLER,

Respondent.

---

---

RESPONDENT'S BRIEF IN OPPOSITION

---

---

Bette Midler respectfully prays  
that Young & Rubicam, Inc.'s writ of  
certiorari to review the opinion of the  
United States Court of Appeals for the  
Ninth Circuit entered in this action on  
September 20, 1991 be denied.



STATEMENT OF JURISDICTION

On December 23, 1991 Bette Midler's attorneys received a copy of Young & Rubicam, Inc.'s petition for writ of certiorari from the Ninth Circuit Court of Appeals' opinion in this case which was filed on September 20, 1991.

OPINIONS BELOW

The five opinions below are set forth in Young & Rubicam, Inc.'s petition for writ of certiorari.

STATEMENT OF THE CASE

The statement of the case in Young & Rubicam, Inc.'s petition contains certain omissions and inaccuracies with respect to facts which are material to the question that this Court is being requested to review. Respondent Bette Midler submits the following statement

of the case in an effort to correct those omissions and inaccuracies.

This action arose out of the television broadcast of commercial advertisements for Lincoln-Mercury automobiles in 1986. Young & Rubicam, Inc. designed the advertisements to convey the impression that Bette Midler was singing for their commercial. (App. A11). Young & Rubicam, Inc. accomplished this deception by utilizing Ula Hedwig, a former background singer for Bette Midler to sound as much like Bette Midler as possible while she was making the recording which was used for the television advertisement. (App. A10).

Midler commenced this action by filing a complaint on April 29, 1986. (App. A56). A first amended complaint was filed on May 27, 1986. Midler's first amended complaint alleged the

following four substantive causes of action: (1) unfair competition, (2) violation of Midler's right of privacy, (3) violation of Midler's right of publicity and (4) violation of California Civil Code §3344. (App. A56.) Midler sought compensatory damages, punitive damages, injunctive relief and an accounting of profits.

In its petition, Young & Rubicam, Inc. correctly states that its cross-motion for summary judgment on Midler's first amended complaint was granted by the District Court on July 13, 1987. (Petition at 13). However, Young & Rubicam, Inc. has failed to inform the Court that the District Court's decision was entirely based on its finding "that Plaintiff has no protectable rights under the laws of California." (App. A60.) The District Court specifically indicated that its decision to

grant Young & Rubicam's Inc.'s motion for summary judgment was not based on the determination that the rights that Midler sought to assert were preempted by federal copyright laws when it stated "the Court, however, need not, and does not decide this issue." (App. A60).

On June 22, 1988, the Ninth Circuit reversed the District Court order granting Young & Rubicam, Inc.'s motion for summary judgment. Midler v. Ford Motor Co., 849 F.2d 460, (9th Cir. 1988) (App. A41.) ("Midler I").

In its petition, Young & Rubicam, Inc. incorrectly states that the Court in Midler I rejected Midler's "claims under Cal. Civil Code §3344 and the common law of unfair competition and invasion of privacy..." (Petition at 14). The truth is that the Midler I court only rejected Midler's claims

under Civil Code §3344 and for unfair competition, not her claim for invasion of privacy. (App. A46.) The Midler I court cited the case of Motschenbacher v. R.J. Reynolds Tobacco Co., 498 F.2d 821 (9th Cir. 1974) for the proposition that "California will recognize an injury from 'an appropriation of the attributes of one's identity'" (App. A47). The Motschenbacher decision in turn relies on both common law causes of action for invasion of right of privacy and publicity under California law.

Young & Rubicam, Inc. makes a further misstatement of fact when it cites in its statement of the case that its conduct with respect to the imitation of Midler's voice was consistent with the 1970 Ninth Circuit Court of Appeals decision in Sinatra v. Goodyear Tire & Rubber Co., 435 F.2d 711 (9th Cir.

1970), cert. denied, 402 U.S. 906 (1971). The truth is that the the conduct which Midler alleged Young & Rubicam, Inc. engaged in was not consistent with the Sinatra case. As stated in Midler I:

If Midler were claiming a secondary meaning to "Do You Want To Dance" or seeking to prevent the defendants from using that song, she would fail like Sinatra. But that is not this case. Midler does not seek damages for Ford's use of "Do You Want To Dance," and thus her claim is not preempted by federal copyright law. (App. A45)

At the time the Midler I court remanded the case to the District Court in June 1988, Young & Rubicam, Inc.'s answer to the first amended complaint contained an affirmative defense of federal copyright preemption. (C.A. SER 5) Young & Rubicam, Inc. failed to disclose in its statement of the case that, subsequent to the remand, the District Court's February 8, 1989 order

granting Plaintiff's motion for partial summary judgment included a ruling that Midler was entitled to summary judgment as to Young & Rubicam, Inc.'s affirmative defense of preemption by copyright law. (App. A32). In fact, the District Court granted summary judgment as to the federal copyright law preemption defense because Young & Rubicam, Inc. had not presented any evidence whatsoever to support the affirmative defense in opposition to Midler's motion for partial summary judgment.

As a result of the District Court's February 8, 1989 ruling on Midler's motion for partial summary judgment, Young & Rubicam, Inc.'s federal copyright law preemption defense was not at issue at the jury trial in this action which commenced on October 24, 1989. Indeed, the following jury instruction was given at the trial in this case:

"There were no issues of copyright law, as such, for you to decide in this case." (C.A. App. SER at 120.) The District Court charged the jury with determining the following facts only:

(1) Whether Young & Rubicam, Inc. deliberately imitated Bette Midler's voice in producing Ford Motor Company's Sable automobile television commercial, and, if the answer to the first question is "Yes", then,

(2) The fair market value of Bette Midler's voice. (C.A. App. SER at 118.)

In its second appeal, Young & Rubicam, Inc. did not raise any issue concerning the propriety of the District Court's February 8, 1989 order granting Midler partial summary judgment with respect to Young & Rubicam, Inc.'s affirmative defense of federal copyright law preemption.

In its petition, Young & Rubicam, Inc. makes the following misrepresentation concerning the record of the trial



in this case: "The evidence was largely uncontradicted and demonstrated that the petitioner intended to imitate the 1972 sound recording of 'Do You Want To Dance.'" (Petition at 16). This statement is belied by the verdict in this case which reflects the jury finding that Young & Rubicam, Inc. had indeed intended to imitate Bette Midler's voice in its television commercial.

Young & Rubicam, Inc.'s misrepresentation of the record concerning the evidence of its intent to imitate Midler's voice is also disclosed by the Ninth Circuit's decision on Young & Rubicam, Inc.'s cross-appeal issued on September 20, 1991. In response to Young & Rubicam, Inc.'s contention that the District Court had improperly denied its motion for directed verdict the Ninth Circuit held that "sufficient evidence was presented to support the

jury's finding that Young & Rubicam, Inc. deliberately imitated Midler's voice." (App. A9.) Among other evidence, the Ninth Circuit cited the following as particularly probative of Young & Rubicam, Inc.'s intent to imitate Midler's voice:

For instance, Hedwig testified that she was contacted by a Young & Rubicam employee "about sending an audio cassette of myself sounding like Bette Midler as a sort of audition tape for this upcoming jingle." . . . She also testified that she was instructed to sound as much like Midler as possible while making the recording. (App. A10)

In summary, Young & Rubicam, Inc. has distorted the record of this case in its petition in order to support its contention that a serious issue of federal copyright law is involved in this action. Young & Rubicam, Inc. has tried to accomplish its purpose first by misrepresenting to the Court the evidentiary finding made below that

Young & Rubicam, Inc. had deliberately intended to imitate Midler's voice, as opposed to the sound recording of Bette Midler's version of "Do You Wanna Dance", and second, by failing to disclose to the Court that the federal copyright preemption defense contained in its answer to the first amended complaint in this case was disposed of by the District Court's February 8, 1989 order of partial summary judgment and that this order was not challenged in their subsequent appeal to the Ninth Circuit. A true reading of the record in this case reveals that there is no basis in the record for this Court to address the issue of federal copyright preemption presented by Young & Rubicam, Inc.'s petition for writ of certiorari.

REASONS FOR DENYING THE WRIT

The Ninth Circuit's holding in Midler I is narrowly drawn to address the unusual factual situation before it and it will effect very few persons other than the parties involved. More than three years after the Midler I decision was issued, there are currently no cases pending anywhere in the United States which raise the alleged conflict between the right to imitiate sounds recordings provided in §114 (b) in the Copyright Act and state common law rights protecting appropriation of voice which Young & Rubicam, Inc. urges this Court to review.

The Midler I decision is not in conflict with the decision of any other court and is in fact consistent with the First Circuit's decision in Lahr v. Adell Chemical Co., 300 F.2d 256 (1st Cir. 1962) and the Ninth Circuit's own

opinion in Sinatra v. Goodyear Tire & Rubber Company, 435 F.2d 711 (9th Cir. 1970) cert. denied 402 U.S. 906 (1971). Moreover, The Midler I decision is consistent with the policy reflected in §301(b) of the Copyright Act and affirmed by this Court in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562 (1977) which is to encourage the creativity of those who use their talents to attain notoriety by protecting aspects of their persona.

The state common law which was affirmed by the Court in Midler I does not conflict with any of the rights granted by the Copyright Act. Young & Rubicam, Inc.'s argument that Midler I imposes liability for conduct permitted by §114(b) of the Copyright is based on its misinterpretation of that provision. In actuality, §114(b) of the Copyright Act is inapplicable to the

facts of this case because it is concerned with imitation of a "sound recording" by a person who is making "another sound recording" not an "audio-visual work" such as Young & Rubicam, Inc.'s Ford television commercial.

ARGUMENTPOINT I

THE PREEMPTION QUESTION RAISED BY  
YOUNG & RUBICAM, INC. WITH RESPECT  
TO MIDLER I DOES NOT CONSTITUTE  
AN IMPORTANT ISSUE OF FEDERAL  
COPYRIGHT LAW WORTHY OF  
SUPREME COURT REVIEW

Young & Rubicam, Inc. has totally failed to show why the Midler I decision is of sufficient importance to proper statutory construction of the Copyright Act so as to warrant Supreme Court review.

The importance of a decision involving statutory construction or application can be shown by demonstrating that the issue is novel or troublesome and involved in numerous cases pending in lower courts, thereby making desirable an early and definitive ruling by

the Supreme Court. Lainq v. United States, 423 U.S. 161, 167 (1976). (Seventy pending cases in federal courts). The importance of a decision involving construction of a federal statute may grow out of the fact that many individuals are involved or are effected by the decision below. Patterson v. Lamb, 329 U.S. 539 (1947). The importance of a decision construing a federal statute may also be established by showing that the decision will seriously effect administration of the law. Rothensies v. Electric Battery Co., 329 U.S. 296 (1946).

None of the above criteria of importance are present in this case. Although Midler I was decided in June 1988, there is currently not a single case pending anywhere in the United States which turns on whether a professional singer's distinctive voice can



be imitated in a television commercial. Furthermore, even under its broadest reading, very few persons are effected by the Midler I decision. The Midler I Court was careful to limit its holding to the parties and factual situation before it:

We need not and do not go so far as to hold that every imitation of a voice to advertise merchandise is actionable. We hold only that when a distinctive voice of a professional singer is widely known and is deliberately imitated in order to sell a product, the sellers have appropriated what is not theirs and have committed a tort in California. (App. A48)

In light of the narrow holding in Midler I, the following claim made by Young & Rubicam, Inc. in the conclusion of its petition concerning its broad application is simply spurious:

Every artist who has performed a song which she has also recorded could, under the concept of "fixed" expressed in Midler I, assert state-created rights against those who subsequently imitate the song simply by claiming that she is as-

serting rights in the sound of her voice and not in the sound recording containing her performance of the song. (App. A50)

Young & Rubicam, Inc.'s claim is false for several reasons. Midler I does not give "every artist" standing to make a claim for misappropriation of their voice, only those that are (1) professional singers, (2) with distinctive voices and (3) are widely known. Furthermore, Midler I does not allow artists to "assert state created rights against those who subsequently imitate the song" that the artist has previously recorded. Rather, it only subjects those to liability who deliberately imitate a singer's voice in order to sell a product.

Because of the way the Midler I Court limited its holding, the rights it recognized only affect those in the advertising business who try to deceive

purchasers about the association of well known singers with their products.

## POINT II

### THE NINTH CIRCUIT'S OPINION IN MIDLER I DOES NOT CONFLICT WITH THE OPINION OF ANY OTHER CIRCUITS ON THE ISSUE OF PREEMPTION

A conflict of authority relied upon as a reason to grant a writ of certiorari normally must be direct, with a case in another appellate court or a Supreme Court decision which is substantially indistinguishable. See Layne & Co. v. Western Well Works, 261 U.S. 387 (1923); Wisconsin Electric Co. v. Dumove Co., 282 U.S. 813 (1930).

Here, Young & Rubicam, Inc. contends that the opinion of the Court in Midler I conflicts with the Seventh Circuit's holding in Baltimore Orioles v. Major League Baseball Players, 805

F.2d 663 (7th Cir. 1986) cert. denied,  
48 U.S. 941 (1987).

The Baltimore Orioles and the instant case have no factual similarities whatsoever. The instant case involved a one time dispute between a well known singer and major advertising agency who had no contractual relationship with each other and concerning the advertising agency's imitation of the singer's voice in a television commercial without her consent.

Baltimore Orioles involved a long-standing dispute between the Major League Baseball Clubs and the Major League Players Association regarding the ownership of the broadcast rights to the players' performances during Major League baseball games. The Players Association contended that the telecasts were being made without its members consent, thereby violating

their rights of publicity. On the other hand, the Clubs contended that the telecasts were made within the scope of the players' employment agreement. Thus, the Clubs claimed exclusive ownership of the copyrights to the telecasts under the "works made for hire" doctrine of 17 U.S.C. §201(b).

Putting aside the fundamental factual differences between Baltimore Orioles and the instant case, there is absolutely no conflict between the principles of law enunciated in the two cases.

The Baltimore Orioles Court held that the players' right of publicity in their recorded performances were preempted because the performances at issue had been "fixed in a tangible medium of expression" within the meaning of §101 of the Copyright Act. The Court pointed out that for a work to be

"fixed" as defined by §101, a work must be recorded "by or under the authority of the author..." Id. at 675 n.22. The Court concluded that the players had given their consent to record their performances to the Clubs through pertinent provisions in their contracts and thus the Clubs had obtained authority of the author of the work. Id. at 670-673.

Although the Baltimore Orioles Court found that the players' rights of publicity had been preempted in the games that had already been recorded, it was careful to delineate the scope of its decision:

It is, of course, true that unrecorded performances per se are not fixed in tangible form.. Thus, if a baseball game were not broadcast or were telecast without being recorded, the players' performances similarly would not be fixed in tangible form and their rights of publicity would not be subject to preemption. Id. at p. 674.

The Midler I decision is consistent with Baltimore Orioles in that the Midler I court held that Midler's voice was protectible because it was not "fixed" in a tangible form, or particular recording of a vocal performance. (App. A46). Furthermore, Young & Rubicam, Inc. did not have a contractual relationship with Midler whereby it recorded its television commercial "by or under the authority" as the Clubs did with the players in Baltimore Orioles. In summary, although Baltimore Orioles and the instant case are factually extremely dissimilar, the principles of the law applied in the cases are easily reconcilable.

Additionally, it should be noted that the Midler I decision is consistent with the sound-alike case decided by the First Circuit in Lahr v. Adell Chemical Co., 300 F.2d 256 (1st Cir.

1962) as well as Sinatra v. Goodyear Tire & Rubber Company, 435 F.2d 711 (9th Cir 1970) cert. denied, 402 U.S. 906 (1971), the only other sound-alike case decided by the Ninth Circuit.

The case of Tin Pan Apple, Inc. v. Miller Brewing Co., Inc., 737 F.Supp. 826 (S.D.N.Y. 1990) is cited by Young & Rubicam, Inc. as refusing to extend the Midler I holding. In fact, Tin Pan Apple, Inc. has no relevance to the issues in this case because it was decided solely under New York statutory law. Id. at 837. The District Court Judge specifically noted that Midler I had no bearing on the case before him because it was decided under California law. Id. at 838.



POINT III

THE PREEMPTION QUESTION POSED BY  
YOUNG & RUBICAM, INC. SHOULD NOT BE  
REVIEWED BECAUSE YOUNG & RUBICAM, INC.  
DID NOT PRESERVE THE QUESTION IN THE  
COURT OF APPEALS

The Supreme Court's normal practice is to refrain from addressing issues not raised in the Court of Appeals. Roberts v. Lodge, 45 U.S. 613, 628 n.n. 10 (1982); Heckler v. Campbell, 461 U.S. 458, 468-469 n. 12 (1983 ; Kosak v. U.S., 465 U.S. 848, 850 n. 3 (1984).

Young & Rubicam, Inc. has failed to preserve the question of whether Bette Midler's claim for misappropriation of her voice is preempted by §301 of the Copyright Act by failing to raise all issues related to the preemption question in the Court of Appeals and in its petition for writ of certiorari.

Young & Rubicam, Inc.'s answer to

the first amended complaint alleged an affirmative defense of preemption by provisions of the Copyright Act. (C.A. App. SER 5). The District Court granted Bette Midler's motion for partial summary judgment as to Young & Rubicam, Inc.'s affirmative defense of copyright preemption in its order dated February 8, 1989. (App. A32).

Young & Rubicam, Inc. never raised the issue of whether the District Court properly granted summary judgment as to its affirmative defense of copyright preemption in the Court of Appeals and has not raised the issue in its petition for writ of certiorari. Therefore, Young & Rubicam, Inc. has not taken the steps necessary to preserve the copyright preemption question it is requesting this Court to review.

Further, as a matter of fairness and judicial economy, Young & Rubicam,

Inc. should not now be heard by this Court on the preemption issue. The preemption issue was ripe for a petition for writ of certiorari after the Ninth Circuit ruling in Midler I. If there was any merit to the issue it should have been addressed at that stage of the case. Instead, the parties and the courts went forward with a jury trial in the District Court and yet another appeal in the Ninth Circuit, with all of the attendant costs to the parties, as well as the considerable burden on the court system. If Young & Rubicam, Inc. wished to seek this Court's review on the preemption issue there was no reason not to do so after Midler I. Now, unhappy with the results of the jury trial, they seek this Court's review without regard for the very con-

siderable expenditure of time and resources since Midler I.

#### POINT IV

THE MIDLER I DECISION DID NOT IMPOSE LIABILITY ON YOUNG & RUBICAM, INC. FOR CONDUCT PERMITTED BY THE COPYRIGHT ACT

The primary reason Young & Rubicam, Inc. gives for granting its writ of certiorari is that the Midler I decision imposed liability on it for conduct which §114(b) of the Copyright Act explicitly permits. In actuality, §114(b) of the Copyright Act is inapplicable to the facts of this case because it applies only to the permitted imitation of a sound recording in another sound recording. It does not apply to an imitation of a sound recording being incorporated into an audio-visual work, such as a television commercial.

Young & Rubicam, Inc. contends that its right to imitate Midler's sound recording of "Do You Want To Dance" in a television commercial is set forth in §114(b) of the Copyright Act. §114(b) of the Copyright Act states in pertinent part:

The exclusive rights of the owner of copyright in a sound recording under clauses (1) and (2) of §106 do not extend to the making or duplication of another sound recording that consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate those in the copyrighted sound recording. (Emphasis added.)

The term "sound recording" is defined in §101 of the Copyright Act as follows:

"Sound Recordings" are works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture or other audiovisual work, regardless of the nature of the material objects, such as disks, tapes or other phonorecords, in which they are embodied. (Emphasis added.)

The definition of sound recordings excludes sound tracks accompanying "audio-visual works". "Audiovisual works" are defined in §101 of the Copyright Act as follows:

"Audio-visual works" are works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.

The provisions of the Copyright Act set forth above reveal that §114(b) has no application to the facts of this case because even if one accepts Young & Rubicam, Inc.'s contention that it was imitating the sound recording of "Do You Want To Dance," it was imitating it in connection with the creation of an "audiovisual work", i.e., the Lincoln-Mercury television commercial, not "another sound record-

ing" as permitted by §114(b). Since imitating a sound recording in the making of an audio-visual work such as a television commercial, is not conduct which §114(b) permits, the Midler I Court's imposition of liability for imitation of a voice in a television commercial does not give rise to any conflict whatsoever with the provisions of §114(b).

#### POINT V

THE TORT RECOGNIZED IN MIDLER I IS NOT PREEMPTED BY §301 OF THE COPYRIGHT ACT DOES NOT CONFLICT WITH THE HOLDING IN BONITO BOATS AND DOES NOT INTERFERE WITH THE REGULATORY SCHEME

#### ESTABLISHED BY CONGRESS

Section 301(a) of the Copyright Act set forth two conditions that both must be satisfied for preemption of a right under state law: First, the work in

which the right is asserted must be fixed in tangible form and come within the subject matter of copyright as specified in §102. Second, the right must be equivalent to any or all of the rights specified in §106. Baltimore Orioles v. Major League Baseball Players 805 F.2d 663, 674 (7th Cir. 1986). The tort recognized by Midler I does not satisfy either of the two conditions for preemption.

The Midler I court made it clear that it was affording protection to Bette Midler's voice as an element of her persona, a type of subject matter which certainly is not eligible for copyright protection. In affording such protection the Midler I court was doing no more than affirming the traditional state protection of aspects of persona such as name and likeness.

Young & Rubicam, Inc.'s contention



that Bette Midler's right to protect her voice from misappropriation under state law is preempted because certain of her vocal performances have been "fixed" and embodied in sound recordings does not withstand scrutiny. When Young & Rubicam, Inc.'s contention is followed to its natural conclusion, the illogical outcome is that if someone consents to have a photograph made of his face, then he is precluded from asserting any common law rights of publicity or privacy against anyone else who appropriates the likeness of his face because those rights would be preempted by the Copyright Act. As the Court in Midler I stated, "A voice is as distinctive and personal as a face." (App. A47.)

In its petition, Young & Rubicam, Inc. contends that Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S.

141 (1987), decided after Midler I, "explained the preemptive force of Article 1, Section 8 of the United States Constitution" in a way that requires preemption of the California common law rights recognized in Midler I. (Petition at 47.)

If anything can be said about Bonito Boats, it is that the decision represents a step back from the broad preemptive approach of earlier patent decisions. Discussing Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964) and Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), the Bonito Court rejected a broad and literal reading of these cases, noting that such a broad reading would improperly preclude state regulation or "'anything under the sun that is made by man,'" Bonito Boats, 489 U.S. at 154, quoting Diamond v. Chakrabarty, 447 U.S. 303,

309 (1980). While Sears and Compco might be read as suggesting that patent and copyright preemption is derived from the patent and copyright clauses of the Constitution, Bonito Boats takes pains to point out, in line with post Sears/Compco cases, that "the Patent and Copyright Clauses do not, by their own force or by negative implication, deprive the States of the power to adopt rules for the promotion of intellectual creation within their own jurisdictions." Bonito Boats, 489 U.S. at 165.

Bonito Boats does not purport to construe §301 of the Copyright Act and adds nothing new to the contentions of Young & Rubicam, Inc. originally rejected by the Ninth Circuit in Midler I.

Finally, the tort recognized in Midler I does not interfere with the

regulatory scheme established by the Copyright Act since §301(b) thereof expressly reserves the rights and remedies available under state statutes and common law concerning subject matters that are not eligible for copyright protection. The court in Zacchini v. Scripps-Howard Broadcasting Co., 433 U.S. 562, 571 (1977) recognized that states' protection of aspects of personas encouraged creativity by protecting those who used their talents to attain notoriety and did not conflict with the policies behind copyright law. The numerous articles that have been written about the Midler I decision which are cited by Young & Rubicam, Inc. in their petition all agree with the result reached by the Court of Appeals. (Petition at 41 n.7.)

CONCLUSION

For the foregoing reasons, Respondent Bette Midler respectfully requests that Petitioner Young & Rubicam, Inc.'s petition for a writ of certiorari be denied.

Dated: Los Angeles, California

January 17, 1992

Respectfully submitted,

Peter Laird, Esq.  
Ralph C. Loeb, Esq.  
ARROW EDELSTEIN & LAIRD, P.C.  
9220 Sunset Boulevard, #302  
Los Angeles, California 90069  
(310) 274-6184

Counsel of Record For  
the Respondent

